

REMARKS

Claims 1-27 are pending in this application. No claim has been amended herein, since each of Applicants' base claims 1, 8, 15, 24 and 27 is believed to be distinguishable over the cited prior art, including Katz et al., U.S. Patent No. 5,926,624; Fuchigami et al., U.S. Patent No. 5,960,398; and Bersson, U.S. Patent No. 6,081,897.

Claim 1 stands finally rejected under 35 U.S.C. §101 for reasons stated on pages 4-5 of the final Office Action (Paper No. 20060623). Again, the Examiner alleges that base claim 1 merely claims "non-functional descriptive material" recorded on a readable medium, which is not statutory under 35 U.S.C. §101. According to the Examiner, the definition of "non-functional descriptive material" includes but is not limited to music, literary works and compilation or mere arrangement of data. See MPEP §2106, Sec., IV, B1.

Previously, base claim 1 had been amended to specify the functional correlation between the information recorded on a recording medium and an apparatus used to identify at least the copyright owner of the original content and the maker of the remake content. Specifically, base claim 1 defines a recording medium comprising:

a remake content made based on at least one **original content**; and
copyright information corresponding to the remake content, the
copyright information including original copyright information which, when
processed by an apparatus, causes the apparatus to identify at least a copyright
owner of the original content, and remake copyright information which, when
processed by the apparatus, causes the apparatus to identify at least a maker of
the remake content.

Nevertheless, on page 2 of the final Office Action (Paper No. 20060623), the Examiner asserts that base claim 1 contains no requisite functionality to satisfy the practical application requirement under 35 U.S.C. §101. According to the Examiner, the processed information is still original information which has not been changed in any way to create a tangible result, and

"applicant simply defines/identifies information on the medium identifying the copyright owner of the original piece of data and the maker of the remake content, but lacks the functional correlation with a computer system."

However, the Examiner's assertion is simply incorrect. In the same cited Sec. IV, B1 of MPEP §2106, descriptive material can be characterized as either "functional descriptive material" or "non-functional descriptive material." "Functional descriptive material" is defined as

consisting of data structures and computer programs which impart functionality when employed as a computer component. The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." (The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) This is in contrast to the definition of "non-functional descriptive material" which includes but is not limited to music, literary works and a compilation or mere arrangement of data, as selected by the Examiner.

In the present situation, base claim 1 defines a data structure of a **remake content** made based on at least one **original content**; and **copyright information** corresponding to the remake content, wherein the copyright information includes (1) original copyright information which, when processed by an apparatus, causes the apparatus to identify at least a copyright owner of the original content, and (2) remake copyright information which, when processed by the apparatus, causes the apparatus to identify at least a maker of the remake content. As clearly defined in Applicants' base claim 1, both the original copyright information and the remake copyright information impart functionality, that is, to identify at least a copyright owner of the original content and at least a maker of the remake content, when employed as a computer component, as required by Sec. IV, B1 of MPEP §2106. Clearly, when "functional descriptive material" is recorded on a computer-readable medium, as is defined in Applicants' base claim 1, it becomes structurally and functionally interrelated to the medium and will be statutory since use of technology permits the function of the descriptive material to be realized.

In view of these reasons and practical application requirement under 35 U.S.C. §101, Applicants respectfully request that the rejection of base claim 1 be withdrawn.

Claims 1, 6, 8, 9, 11-13 and 15 stand finally rejected under 35 U.S.C. §102(b) as being anticipated by Katz et al., U.S. Patent No. 5,926,624 for reasons stated on pages 5-7 of the final Office Action (Paper No. 20060623). In support of the rejection of Applicants' base claim 1, the Examiner asserts that Katz '624 discloses,

"a remake content based on at least one original content; (Katz, Col. 6 Lines 47-50, selected preview clips) and copying right information corresponding to the remake content, the copyright information including original copyright information which, when processed by an apparatus, causes the apparatus to identify at least a copyright owner of the original content and remake copyright information which, when processed by the apparatus, causes the apparatus to identify at least a maker of the remake content (Katz, Col. 6 Lines 55-61)."

However, the Examiner's assertion is simply incorrect and should be withdrawn.

Applicants submit that these features of Applicants' base claim 1 are **not** disclosed or suggested by Katz '624 in the manner suggested by the Examiner. Therefore, Applicants respectfully request the Examiner to reconsider and withdraw this rejection for the following reasons.

Base claim 1, as amended, clearly defines a recording medium which comprises two types of information: (1) remake content based on at least one original content, as shown in FIG. 1; and (2) copyright information, as shown in FIG. 1, including both (a) original copyright information which, when processed by an apparatus, causes the apparatus to identify at least a copyright owner of the original content, and (b) remake copyright information which, when processed by an apparatus, causes the apparatus to identify at least a maker of the remake content, as shown in FIG. 4. This way the copyright of the original content can be advantageously protected, while the personal use rights of an individual user on the original content can be guaranteed.

In contrast to Applicants' base claim 1, Katz '624 discloses a computer network based digital information library system, as shown in FIG. 2, in which a client computer system 214 or a mobile playback system 212 at a client site 210 can access a library server 260 for an indexed collection of digital information obtained from different sources, such as books, daily news, entertainment feeds, conferences and educational sources, via a distribution network 240 at a library site 250.

At the library site 250, an authoring system 280 is used to edit, index, compress, scramble, segment, and catalog digital information content into digital information files for storage on the library server 260. Such an authoring system 280 can also be used to partition digital information content into segments, which can be identified, searched, and skipped over if desired. As shown in FIG. 3, the authoring system 280 contains a preview generator 232 which generates preview clips 324 for providing short pre-generated portions of digital information content used to give a consumer a sense of the content of a particular digital information file. As further described on column 6, lines 42-68 of Katz '624,

"[T]he raw digital information content 310 is also fed to template header generator 312. Each digital information file maintained by the library server 260 includes other descriptive information used to identify the file's content and to provide information used to process the digital information within the file. **Each digital information file includes a template header**, a descrambling map, selected preview clips, and the digital information programming itself. In the preferred embodiment, the template header comprises a number of attributes corresponding to the digital information in the file. For example, the digital

information may be audio information generated from the content of a book or other published work. In this example, the audio file template header contains attributes including: 1) the title of a book, volume, or medium from which the digital information content originated, 2) the legal copyright associated with the digital information content, 3) audible title(s) of the content, 4) a table of contents of the content, and 5) playback settings for appropriately playing or rendering the digital information. The table of contents contains content navigation information including but not limited to: the number of chapters, the length of the program, and information indicative of the relevant content sections. The table of contents is generated with input from authoring system operator 305 or automatically by analysis of digital information content 310."

However, there is **no** disclosure from Katz '624 of Applicants' efforts to record on a recording medium: (1) remake content based on at least one original content, as shown in FIG. 1; and (2) copyright information, as shown in FIG. 1, including both (a) original copyright information which, when processed by an apparatus, causes the apparatus to identify at least a copyright owner of the original content, and (b) remake copyright information which, when processed by an apparatus, causes the apparatus to identify at least a maker of the remake content, as shown in FIG. 4, which can ensure copyright protection of the original content, while securing the personal use rights of an individual user on the original content, as generally defined in Applicants' base claim 1.

Previously, the Examiner cited column 6, lines 55-61 of Katz '624 for allegedly disclosing "the copyright information corresponding to the remake content ... including original copyright information to identify at least a copyright owner of the original content, and remake copyright information to identify at least a maker of the remake content." However, the cited column 6, lines 55-61 of Katz '624, as Applicants pointed out in the Amendment filed on April 11, 2006, only refers to the use of a file header in each digital information file for storage in a library server²⁶⁰, including attributes, such as, for example, the legal copyright associated with the original content, i.e., a digital information file. There is **no** disclosure or suggestion anywhere in Katz '624 of Applicants' claimed "remake copyright information used to identify at least a maker of the remake content" as expressly defined in Applicants' base claim 1.

Nevertheless, on pages 3-4 of the final Office Action (Paper No. 20060523), the Examiner has shifted to column 42 extending to column 67 of Katz '624, and now argues that,

"Katz discloses remake content based on at least one original content, copyright information, including original copyright information which, when processed by an apparatus, causes the apparatus to identify at least a copyright owner of the original content, and remake copyright information which, when

processed by an apparatus, causes the apparatus to identify at least a maker of the remake content (Katz, Col. 42 - 67)."

The Examiner's new line of arguments is, however, without any basis in fact. First of all, there is **no** Col. 42 -67 anywhere in Katz '624 as asserted by the Examiner. Katz '624 only has Col. 1 - 18, all describing a computer network based digital information library system, as shown in FIG. 2, in which a client computer system 214 or a mobile playback system 212 at a client site 210 can access a library server 260 for an indexed collection of digital information obtained from different sources, such as books, daily news, entertainment feeds, conferences and educational sources, via a distribution network 240 at a library site 250.

The Examiner also asserts that "the copyright information represents both the original data and the remake data." However, the Examiner's assertion is completely incorrect. Applicants' base claims 1, 8 and 15 do not simply define that the copyright information represents both the original data and the remake data, as mistakenly asserted by the Examiner. Rather, Applicants' base claim 1, for example, expressly defines that the copyright information, as shown in FIG. 1, includes both (a) original copyright information which, when processed by an apparatus, causes the apparatus to identify at least a copyright owner of the original content, and (b) remake copyright information which, when processed by an apparatus, causes the apparatus to identify at least a maker of the remake content, as shown in FIG. 4. This way the copyright of the original content can be advantageously protected, while the personal use rights of an individual user on the original content can be guaranteed.

Likewise, in support of the rejection of Applicants' base claim 8, the Examiner asserts that Katz '624 discloses,

"making a remake content based on at least one original content (Katz, Col. 6 Lines 47-50, Selected preview clips), recording the remake content on the recording medium (Katz, Col. 8 Lines 32-42, transfer to client computer) and generating and recording copyright information corresponding to the remake content on the recording medium, the copyright information including original copyright information to identify at least a copyright owner of the original content and remake copyright information to identify at least a maker of the remake content on the recording medium (Katz, Col. 6 Lines 55-61)."

Again, as previously discussed, the Examiner's assertion is factually incorrect. Contrary to the Examiner's assertion, the cited column 6, lines 55-61 of Katz '624 only refers to the use of a file header in each digital information file for storage in a library server260, including attributes, such as, for example, the legal copyright associated with the original content, i.e., a digital

information file. There is **no** disclosure or suggestion anywhere in Katz '624 of Applicants' claimed "remake copyright information used to identify at least a maker of the remake content" as expressly defined in Applicants' base claim 8.

Similarly, in support of the rejection of Applicants' base claim 15, the Examiner also asserts that Katz '624 discloses,

"a converting unit to convert at least one original content into a remake content (Katz, Fig. 3 Item 323), a processor to generate copyright information including original copyright information on the original content and remake copyright information including identification information relating to said apparatus on the remake content (Katz, Col. 6 Lines 23-30 and Lines 55-61), and a recording unit to record the remake content obtained by the converting unit, the identification information and the copyright information generated by the processor on a recording medium (Katz, Col. 8 Lines 32-42, transfer to client computer."

Again, the Examiner's assertion is also factually incorrect. Contrary to the Examiner's assertion, the authoring system 280 of Katz '624 is **not** and **cannot** be interpreted to read on Applicants' claimed "processor to generate copyright information including original copyright information on the original content and remake copyright information including identification information relating to said apparatus on the remake content" as defined in Applicants' base claim 15. As previously discussed, such an authoring system 280 is only used at a library site 250 to edit, index, compress, scramble, segment, and catalog digital information content into digital information files for storage on the library server 260. Moreover, the information transferred to a client computer 214 at a client site 210 does **not** include any remake copyright information as alleged by the Examiner.

In summary, the Examiner provides **no** explanation as to how each feature of Applicants' base claims 1, 8 and 15 is anticipated by Katz '624. As is required under 35 U.S.C. §102, the Examiner bears the initial burden of establishing a *prima facie* case of anticipation. Only if this burden is met does the burden of coming forward with rebuttal argument or evidence shift to the Applicants. Ex parte Levy, 17 USPQ2d 1461, 1462 (1990) expressly states:

"it is incumbent upon the examiner to identify wherein each and every facet of the claimed invention is disclosed in the applied reference."

In addition, 37 CFR §1.106(b) requires the Examiner, when rejecting claims for want of

novelty or for obviousness, must cite the best references at his command. When a reference is complex or shows or describes inventions other than that claimed by the Applicants, the particular part relied upon must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

Moreover, in order to anticipate Applicants' base claims 1, 8 and 15 under 35 U.S.C. §102, the Examiner must demonstrate that a single prior art reference discloses each and every feature of the claimed invention, either explicitly or inherently. See Glaxo Inc. v. Novopharm Ltd., 52 F.3d 1043, 34 USPQ2d 1565, 1567 (Fed. Cir. 1995). The absence from the reference of any claimed element negates anticipation. Kloster Speedsteel AB v. Crucible Inc., 793 F.2d 1565, 230 USPQ2d 81 (Fed. Cir. 1986).

In the present situation, the Examiner has **not** explained how Katz '624 teaches each and every elements as defined in Applicants' claims 1, 6, 8, 9, 11-13 and 15 under 35 U.S.C. §102(b), and has therefore failed to meet his initial burden of production. In view of this omission alone, the rejection should be withdrawn.

Dependent claims 2, 3, 4, 5, 7, 19, 20, 21, 22 and 26 stand finally rejected under 35 U.S.C. §103(a) as being unpatentable over Katz et al., U.S. Patent No. 5,926,624, in view of Fuchigami et al., U.S. Patent No. 5,960,398 for reasons stated on pages 8-11 of the final Office Action (Paper No. 20060623). According to the Examiner, Fuchigami '398, as a secondary reference, is cited for allegedly suggesting the use of a copyright embedding apparatus for managing copyrights in a storage medium. However, the rejection is improper because, even if Fuchigami '398 is incorporated into the computer network based digital information library and delivery system as disclosed by Katz '624, the proposed incorporation still does **not** arrive at Applicants' claims 2, 3, 4, 5, 7, 19, 20, 21, 22 and 26. This is because Fuchigami '398 only discloses a copyright information embedding system, as shown in FIG. 1, in which copyright information for copyright protection can be embedded into digital audio signal without deterioration of analog audio reproduced. As acknowledged on column 1, lines 44-48 of Fuchigami '398, conventional system used to embed copyright data into digital data has the drawback in that digital-to-analog (D/A) conversion of the digital data into analog audio data would cause reproduced sound quality to be deteriorated or changed uncomfortably. Again, like Katz '624, Fuchigami '398 does **not** disclose or suggest Applicants' efforts to reproduce from a recording medium: 1) remake content based on at least one original content, as shown in FIG. 1; and 2) copyright information, as shown in FIG. 1, that has both (a) original copyright information

on the original content, and (b) remake copyright information on the remake content, which can ensure copyright protection of the original content, while securing the personal use rights of an individual user on the original content, as generally defined in the base claims.

In order to establish a *prima facie* case of obviousness under 35 U.S.C. §103, the Examiner must show that the prior art reference (or references when combined) must teach or suggest all the claim limitations, and that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, provided with a reasonable expectation of success, in order to arrive at the Applicants' claimed invention. The requisite motivation must stem from some teaching or suggestion to make the claimed combination must be found in the prior art, and **not** based on Applicants' disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP 2143. Furthermore, any deficiencies in the cited references cannot be remedied with conclusions about what is "basic knowledge" or "common knowledge". See In re Lee, 61 USPQ 2d 1430 (Fed. Cir. 2002).

In the present situation, both Katz '624 and Fuchigami '398 fail to disclose and suggest key features Applicants' claims 2, 3, 4, 5, 7, 19, 20, 21, 22 and 26. Therefore, Applicants respectfully request that the rejection of claims 2, 3, 4, 5, 7, 19, 20, 21, 22 and 26 be withdrawn.

Dependent claims 17, 18, 24, 25 and 27 stand finally rejected under 35 U.S.C. §103(a) as being unpatentable over Katz '624, in view of Bersson, U.S. Patent No. 6,081,897 for reasons listed on pages 11-13 of the final Office Action (Paper No. 20060623). Lastly, dependent claim 23 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Katz '624 and Bersson '897, as applied to claims 17, 18, 24 and 27, and in further view of Fuchigami et al., U.S. Patent No. 5,960,398 for reasons stated on pages 13-14 of the final Office Action (Paper No. 20060623). Since these rejections are predicated upon the correctness of the rejection of their respective parent claims, Applicants respectfully traverse these rejections primarily based on the same reasons discussed against the rejection of their respective parent claims.

In view of the foregoing amendments, arguments and remarks, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. Should any questions remain unresolved, the Examiner is requested to telephone Applicants' attorney at the Washington DC office at (202) 216-9505 ext: 232. Applicants respectfully reserve all rights to file subsequent related application(s) (including reissue applications) directed to any or all previously claimed limitations/features which have been amended or canceled, or to any or all

limitations/features not yet claimed, i.e., Applicants have no intention or desire to dedicate or surrender any limitations/features of the disclosed invention to the public.

INTERVIEW:

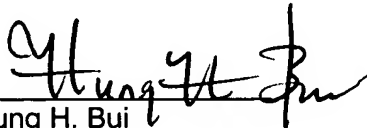
In the interest of expediting prosecution of the present application, Applicants respectfully request that an Examiner interview be scheduled and conducted. In accordance with such interview request, Applicants respectfully request that the Examiner, after review of the present Amendment, contact the undersigned local Washington, D.C. attorney at the local Washington, D.C. telephone number (202) 216-9505 ext. 232 for scheduling an Examiner interview, or alternatively, refrain from issuing a further action in the above-identified application as the undersigned attorneys will be telephoning the Examiner shortly after the filing date of this Amendment in order to schedule an Examiner interview. Applicants thank the Examiner in advance for such considerations. In the event that this Amendment, in and of itself, is sufficient to place the application in condition for allowance, no Examiner interview may be necessary.

To the extent necessary, Applicants petition for an extension of time under 37 CFR §1.136. If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 503333.

Respectfully submitted,

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